

1 Ezra Sutton, Esq.  
2 **EZRA SUTTON, P.A.**  
3 Plaza 9, 900 Route 9  
4 Woodbridge, New Jersey 07095  
5 Telephone (732) 634-3520  
6 Facsimile (732) 634-3511  
7 Admitted *pro hac vice*

8 Local Counsel:  
9 Tom Kohan, Esq.  
10 445 South Figueroa Street  
11 Suite 2700  
12 Los Angeles, CA 90071  
13 Attorneys for Defendant  
14 Age Group, Ltd.

15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**UNITED STATES DISTRICT COURT**  
**FOR THE CENTRAL DISTRICT OF CALIFORNIA**

15 LA PRINTEX INDUSTRIES, INC.,  
16 a California Corporation,

17 Plaintiff,

18 vs.

19 TARGET CORP., a Minnesota  
20 Corporation; et al.,

21 Defendants.

) Case No. 01 CV 06-4640 (DSF)  
) Before the Honorable Dale S. Fischer

) Hearing: January 14, 2008

22  
23 **DEFENDANT AGE GROUP MEMORANDUM OF LAW IN SUPPORT OF**  
24 **DEFENDANT'S MOTION FOR SUMMARY JUDGMENT**  
25  
26  
27  
28

## TABLE OF CONTENTS

	<i>Page #</i>
<b>I. INTRODUCTION.....</b>	<b>1</b>
<b>II. BACKGROUND.....</b>	<b>1</b>
<b>III. LEGAL STANDARDS.....</b>	<b>2</b>
A. Summary Judgment Standard.....	2
B. Derivative Works.....	3
C. Failure To Identify A Pre-Existing Work On A Copyright Application.....	4
<b>IV. ARGUMENT.....</b>	<b>4</b>
A. Presumption of Validity Is Negated Because The Copyright Office Lacked Material Information .....	4
B. Plaintiff had knowledge of the Haller design and not only withheld it from the Copyright Office, but Plaintiff also withheld it from this Court.....	6
C. Plaintiff's copyright registration should be held unenforceable and/or invalid based on Plaintiff's pattern of withholding the Haller design from the Copyright Office and this Court.....	7
<b>V. CONCLUSION.....</b>	<b>7</b>

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**TABLE OF AUTHORITIES**

<u>FEDERAL CASES</u>	<i>Page #</i>
Tarin v. County of Los Angeles, 123 F.3d 1259, 1263 (9th Cir.1997).....	2
Celotex Corp. v. Catrett, 477 U.S. 317, 323-324 (1986).....	2
Russell v. Price, 612 F.2d 1123, 1128 (9 <sup>th</sup> Cir.1979).....	3
Express, LLC v. Fetish Group, Inc., 424 F. Supp 2d 1211 (C.D. Cal. 2006).....	4
 <u>FEDERAL STATUTES</u>	
17 U.S.C. § 101.....	3
17 U.S.C. § 103(b).....	3

1  
2  
3  
4  
5  
6  
7  
8  
9

## 10 **I. INTRODUCTION**

This is Defendant Age Group's Motion for Summary Judgment to hold Plaintiff's copyright registration unenforceable and/or invalid based on Plaintiff's failure to disclose to both the Copyright Office and this Court, on at least three (3) filings with the Court, the pre-existing of the Erika Haller design which, Plaintiff's own Expert witness, Frances Harder, admitted was a substantially similar design to Plaintiff's copyrighted design.

11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

## **II. BACKGROUND**

The Plaintiff here failed to disclose to the Copyright Office that its design or print floral pattern was comprised of a pre-existing design (the Erika Haller design Exhibit 28). In terms of analyzing infringement, this is significant because infringement, or the lack of infringement, must be determined by comparing defendant's floral print to only the novel elements, if any, of Plaintiff's floral design. Section 6 of the copyright application specifically requires an applicant to identify any pre-existing works. This section was left blank in Plaintiff's copyright application and registration.

As a result, the Copyright Office had no idea that Plaintiff did not write the design elements of the floral rose pattern. For example, the Copyright Office did not know that the floral designs were not created by the Plaintiff and are substantially similar to the prior Erika Haller floral design. Then, in this litigation, Plaintiff failed again in a number of pleadings to disclose to this Court the prior Haller design. First, it was not disclosed in the original complaint or in the first amended complaint. Second, it was not disclosed in Plaintiff's Rule 26A disclosures. See Sutton Declaration. Defendant's counsel Sutton learned of the prior Haller design from a prior litigation involving Plaintiff and Defendant's counsel Sutton confronted Plaintiff's counsel with

1 this information in March of 2007. See Sutton Declaration. Shortly thereafter, Plaintiff  
2 was compelled to amend their complaint again to disclose the prior Haller design. See  
3 Sutton Declaration.

4 If Plaintiff's counsel was not confronted with this information, Plaintiff would  
5 never have disclosed in this law suit and to this Court, that Plaintiff's copyrighted  
6 floral print design was substantially similar to the prior Haller Design.

### 7 8 **III. LEGAL STANDARDS**

#### 9 **A. Summary Judgment Standard**

10 Rule 56(c) requires summary judgment when the evidence, viewed in the light  
11 most favorable to the non-moving party, shows that there is no genuine issue as to any  
12 material fact, and that the moving party is entitled to judgment as a matter of law. See  
13 Fed.R.Civ.P. 56(c); *Tarin v. County of Los Angeles*, 123 F.3d 1259, 1263 (9th Cir.1997).  
14 Defendant as the moving party bears the initial burden of establishing the absence of a  
15 genuine issue of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24  
16 (1986). That burden may be met by "showing'-that is, pointing out to the district court-  
17 that there is an absence of evidence to support the nonmoving party's case." *Id.* at 325.  
18 Once Defendant has met its initial burden, Rule 56(e) requires Plaintiff to go beyond the  
19 pleadings and identify facts that show a genuine issue for trial. See *id.* at 323-34;  
20 *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986).

21 There can be no genuine issue as to any material fact where the nonmoving  
22 party's proof is deficient in meeting an essential part of the applicable legal standard.  
23 *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986).

24 Once the Court construes the creative elements, if any, of Plaintiff's derivative  
25 copyrighted design, it will be clear that Age Group's accused design is substantially  
26 different than Plaintiff's copyrighted design and cannot infringe as a matter of law.  
27  
28

1  
2 **B. Derivative Works**

3 As defined by the Copyright statute, “[a] ‘derivative work’ is a work based upon  
4 one or more preexisting works, such as a translation, musical arrangement,  
5 dramatization, fictionalization, motion picture version, sound recording, art  
6 reproduction, abridgement, condensation, or any other form in which a work may be  
7 recast, transformed, or adapted.” 17 U.S.C. § 101. The statutory definitions make it clear  
8 that derivative works require some artistic modification to the underlying works beyond  
9 simply combining them to create a “synergistic artistic work”

10 “The copyright in a compilation or derivative work extends only to the (new)  
11 material contributed by the author of such work, as distinguished from the preexisting  
12 material employed in the work, and does not imply any exclusive right in the preexisting  
13 material. The copyright in such work is independent of, and does not affect or enlarge  
14 the scope, duration, ownership, or subsistence of, any copyright protection in the  
15 preexisting material.” 17 U.S.C. § 103(b).

16 It is well-established in this Circuit that “a derivative copyright protects only the  
17 new material contained in the derivative work, not the matter derived from the  
18 underlying work.” *Russell v. Price*, 612 F.2d 1123, 1128 (9th Cir.1979). Moreover,  
19 copyright holders are only entitled to protection with respect to their original  
20 contributions. As codified in 17 U.S.C. § 103(b), “[t]he copyright in a *compilation or*  
21 *derivative* work extends only to the material contributed by the author of such work, as  
22 distinguished from the preexisting material employed in the work.” (emphasis added).  
23 Whether viewed as a compilation or a derivative work, Palintiff’s copyright cannot  
24 extend beyond its contribution to a work comprised entirely of third-party components.  
25 17 U.S.C. § 103(b). The “bodily appropriation” test provides the necessary safeguards  
26 for preventing extension of the copyright to the underlying components.  
27  
28

1  
2 **C. Failure To Identify A Pre-Existing Work On A Copyright Application**

3 Question 6 of a Copyright Application for a Certificate of Registration from the  
4 United States Copyright Office refers to derivative works or compilations. The form  
5 requires that 6(a) and (b) be completed if the work is derivative and that 6(b) be  
6 completed if the work is a compilation. Question 6(a) requires that an applicant  
7 “[i]dentify any preexisting work or works that [the applicant’s] work is based on or  
8 incorporates.” Question 6(b) requires the applicant to “[g]ive a brief, general statement  
9 of the material that has been added to this work and in which copyright is claimed.”

10 In order for the court to invalidate a copyright certificate on the basis of fraud “the  
11 court would have to find either that (1) the omission was an intentional fraud on the  
12 Copyright office; or (2) that the [moving party] was prejudiced by the omission.”  
13 *Express, LLC v. Fetish Group, Inc.*, 424 F. Supp 2d 1211 (C.D. Cal. 2006). Moreover,  
14 “Inadvertent mistakes on registration certificates do not invalidate a copyright and thus  
15 do not bar infringement actions, unless the alleged infringer has relied to its detriment  
16 on the mistake, or the claimant intended to defraud the Copyright Office by making the  
17 misstatement.” *Id.* (Applicant’s failure to disclose preexisting public domain material  
18 did not raise an issue of triable fact on plaintiff’s intent to defraud the Copyright Office).  
19

20  
21 **IV. ARGUMENT**

22 **A. Presumption of Validity Is Negated Because The Copyright Office**  
23 **Lacked Material Information.**

24 The Copyright Office lacked complete and accurate material information when  
25 evaluating Plaintiff’s copyright application. Therefore, any presumption of validity  
26 normally available to Plaintiff’s copyright registration is negated.  
27  
28

1 Deference to the Copyright Office's registerability determination is improper  
2 where its decision was based on incomplete or misleading information. It is a matter of  
3 law whether information is material. See Whimsicality, Inc. v. Rubie's Costume  
4 Company, Inc., 891 F.2d 452 (2d Cir. 1989).

5 A copyright applicant is expressly required to disclose pre-existing works from  
6 which their claimed work was created. See 17 U.S.C. Section 409 (9). ("The  
7 application for copyright registration... shall include, in the case of a compilation or  
8 derivative work, an identification of any pre-existing work or works that it is based on  
9 or incorporates, and a brief, general statement of the additional material covered by the  
10 copyright claim being registered.")

11 The Plaintiff here failed to disclose to the Copyright Office that its design or print  
12 floral pattern was comprised of a pre-existing design (the Erika Haller design Exhibit  
13 28). Section 6 of the copyright application specifically requires an applicant to identify  
14 any pre-existing works. This section was left blank in Plaintiff's copyright application  
15 and registration.

16 As a result, the Copyright Office had no idea that Plaintiff did not create the  
17 design elements of the floral rose pattern. For example, the Copyright Office did not  
18 know that the floral designs were not created by the Plaintiff and are substantially  
19 similar to the prior Erika Haller floral design. See Exhibits 26 to 28 from the Harder  
20 deposition, and pages 52 to 64 of the Harder deposition (attached to Sutton  
21 declaration), where Plaintiff's expert testified that circled sections A to H of the  
22 Plaintiff's floral pattern (Exhibit 26) are substantially similar to circled sections A to H  
23 of the prior Haller floral pattern (Exhibit 28). Thus, Plaintiff's floral pattern, as  
24 presented to the Copyright Office, was not an original work of art, and this was a  
25 "knowing" and material omission in Plaintiff's copyright application. The knowledge  
26 issue is discussed below in further detail.  
27  
28



1           B.     Plaintiff had knowledge of the Haller design and not only withheld it  
2                 from the Copyright Office, but Plaintiff also withheld it from this Court.

3           As discussed above, the Plaintiff failed to disclose the prior Haller design to the  
4 Copyright Office.

5           Then, in this litigation, Plaintiff failed again in a number of pleadings to disclose  
6 to this Court the prior Haller design. First, it was not disclosed in the original complaint  
7 or in the first amended complaint. Second, it was not disclosed in Plaintiff's Rule 26A  
8 disclosures. See Sutton Declaration. Defendant's counsel Sutton learned of the prior  
9 Haller design from a prior litigation involving Plaintiff, and Defendant's counsel Sutton  
10 confronted Plaintiff's counsel with this information in March of 2007. See Sutton  
11 Declaration. Shortly thereafter, Plaintiff was compelled to amend their complaint again  
12 to disclose the prior Haller design. See Sutton Declaration.

13           If Plaintiff's counsel was not confronted with this information, Plaintiff would  
14 never have disclosed in this lawsuit and to this Court, that Plaintiff's copyrighted floral  
15 print design was substantially similar to the prior Haller Design.

16           C.     Plaintiff's copyright registration should be held unenforceable and/or  
17                 invalid based on Plaintiff's pattern of withholding the Haller design  
18                 from the Copyright Office and this Court.

19           The Harder deposition made it clear that major sections of Plaintiff's pattern  
20 (Exhibit 26) are substantially similar to Haller's design (Exhibit 28). In terms of  
21 analyzing infringement, this is significant because infringement, or the lack of  
22 infringement, must be determined by comparing defendant's floral print to only the  
23 novel elements, if any, of Plaintiff's floral design.

24           It is now clear that Plaintiff's pattern of failing to disclose the prior Haller design  
25 was done in order to prevent this infringement analysis from taking place. That is,  
26 Plaintiff was trying to insure that Plaintiff's design, as a whole, would be compared to  
27  
28

1 Defendant's design to determine infringement, and this would be an improper analysis,  
2 since only the novel elements, if any, should be compared to Defendant's design.

3 For these reasons, Plaintiff's copyright registration should be held unenforceable  
4 and/or invalid.

5  
6 **V. CONCLUSION**

7 In conclusion, based on the foregoing, Defendant respectfully requests that the  
8 Court grant this motion.

9  
10 Respectfully Submitted,

11 AGE GROUP, LTD.

12  
13 By

  
14 EZRA SUTTON, Esq. (*pro hac vice*)

15 EZRA SUTTON, P.A.

16 Plaza 9, 900 Route 9  
17 Woodbridge, New Jersey 07095  
Telephone (732) 634-3520  
Facsimile (732) 634-3511

18 Dated: December 24, 2007

19 (Local Counsel)  
20 Tom Kohan, Esq.  
21 445 South Figueroa Street  
22 Suite 2700  
Attorneys for Defendant  
Age Group, Ltd.